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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/648,666   | 08/26/2003  | Kaoru Yoneyama       | IPO-P857.4          | 3903             |
| 3624   | 7590        | 06/15/2004           | EXAMINER            |                  |
| VOLPE AND KOENIG, P.C.<br>UNITED PLAZA, SUITE 1600<br>30 SOUTH 17TH STREET<br>PHILADELPHIA, PA 19103 |             |                      | SHIN, CHRISTOPHER B |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2182                |                  |

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/648,666  | <b>Applicant(s)</b><br>YONEYAMA, KAORU |  |
|                              | <b>Examiner</b><br>Christopher B Shin | <b>Art Unit</b><br>2182                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/241,017.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, line 8, it is unclear as to whether the "stored and managed" is performed **before or after** the assignment of the file name with a part of the file comprised of a serial number.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "EXTEND-A-NAME" by World Software Corporation (Primary Reference).

- b. The primary reference teaches the claimed limitations as follows:

- A memory device
  - Obvious feature described under "9. Copying files", page 51
- Information to be recorded
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55, the "SJS0001" of "The disk you are on" & "Changing the prefix or suffix for automatic DOS names", pages 94-96,
- File name generator for assigning a file name for information to be recorded so that said information can be formatted as a file and then stored in a recording medium
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55 & "Changing the prefix or suffix for automatic DOS names", pages 94-96
- File name generator automatically assigns the file name with a part of the file name comprised of a serial number stored and managed in the memory device and associated with the file concerned
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55, the "SJS0001 & SJS0002" of "The disk where you want to copy to go" & "Changing the prefix or suffix for automatic DOS names", pages 94-96
- File name generator increments a serial number assigned to the file name and stores the incremented file number for subsequent use
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55 & "Changing the prefix or suffix for automatic DOS names", pages 94-96
- File name generator further includes apparatus for providing characters forming an arbitrary portion for the file name
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55 & "Changing the prefix or suffix for automatic DOS names", pages 94-96
- Apparatus for combining the arbitrary portion with said file number
  - Obvious feature described under "Copying a file and giving it a new DOS name", pages 54-55 & "Changing the prefix or suffix for automatic DOS names", pages 94-96, see also page 95, lines 4-7

5. The difference between the claimed invention and the teachings of the primary reference is that the primary reference does not expressly teach the limitations of the

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preamble; however, the present claimed invention does not utilize or incorporate "image manipulating system" in any way in the body of claims. For example, the claimed "information" is not utilized/incorporated in the environment of "manipulating system".

In addition, it is well known and common knowledge to one of ordinary skill in the art to manage files in varieties of different applications (e.g., image & non-image system environments) for naming and managing files. In fact, this knowledge is no more than common practice to one of ordinary skill in the art at the time of the invention.

Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the primary reference for the reasons state above.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B Shin whose telephone number is 703-305-9658. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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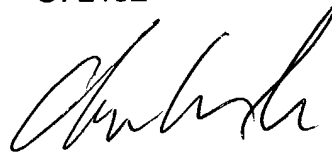
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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Shin  
Primary Examiner  
Of 2182

June 9, 2004  
CBS

A handwritten signature in black ink, appearing to read 'Chris Shin', written in a cursive style.